

REMARKS

This responds to the Office Action mailed on December 28, 2006.

No claims are amended, canceled or added in this response; as a result, claims 1, 3-11 and 19-30 remain pending in this application.

§112 Rejection of the Claims

Claims were rejected under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. In particular, the Office Action stated “the term “tangible” renders the scope of the claim undeterminable.” As stated in the M.P.E.P:

The essential inquiry pertaining to this requirement is whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity. Definiteness of claim language must be analyzed, not in a vacuum, but in light of:

- (1) The content of the particular application disclosure;
- (2) The teachings of the prior art; and
- (3) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made. *M.P.E.P.* § 2173.02.

Applicant notes that the term “tangible” was added in an amendment and response filed March 29, 2006. As discussed in that response, the term “tangible” was added so that “tangible computer readable medium” excluded intangible signals in response to a rejection under 35 U.S.C. § 101. As defined in the *The American Heritage® Dictionary of the English Language, Fourth Edition*, the term “tangible” is defined as “discernible by the touch; palpable”, “possible to touch” or “possible to be treated as fact; real or concrete” thus including media such as CD-ROMs, DVD-ROMs, RAM, hard drives etc. that are material and capable of being touched and excluding signals. Applicant respectfully submits that the term tangible has a reasonable degree of clarity and particularity such that the claim is definite. Applicant respectfully requests reconsideration and the withdrawal of the rejection of claims 8-11 and 19-20.

§103 Rejection of the Claims

Claims 1, 3-11, 19-20, and 25-29 were rejected under 35 USC § 103(a) as being unpatentable over Emens et al. (U.S. 6,606,643) in view of Ramanathan et al. (U.S. 5,913,041). In order for the Examiner to establish a *prima facie* case of obviousness, three base criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *M.P.E.P.* § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)). Applicant respectfully traverses the rejection because the claims contain elements not found in the combination of Emens and Ramanathan.

For example, independent claims 1 as amended recites "wherein the empirical measurement is selected according to a size of data to be obtained from at least one of the plurality of sources." Thus claim 1 recites choosing, based on the size of data to be obtained which of a variety of empirical measurements to use to select a source for the data. Claims 8, 25 and 28 recite similar language related to selecting an empirical measurement. The Office Action correctly states that Emens does not disclose the recited language. However, the Office Action goes on to state that Ramanathan, at column 9, lines 15-23, and 38-59 and at column 7, lines 45-50 discloses the recited language. The reasoning stated in the Office Action is that "throughput measurement is set (selected) only for transfer exceeding 70 KBytes." Applicant respectfully disagrees with this interpretation. As made clear in the cited section of Ramanathan, the measurement is set based on whether the transfer exceeds 70 Kbytes. Contrary to the statement in the Office Action, setting a throughput measurement is quite different from selecting which of several possible empirical measurements is to be used (e.g. throughput, latency, round trip time, earliest response etc.). Again referring to *The American Heritage® Dictionary of the English Language, Fourth Edition*, selection is defined as "To take as a choice from among several; pick out". Ramanathan does not select a throughput based on the size of a transfer, rather Ramanathan sets or determines a throughput based on the size of the transfer. Ramanathan does not disclose selecting or choosing a particular type of performance measurement from a variety

of differing empirical measurements. Thus neither Emens nor Ramanathan teach or suggest each and every element of Applicant's claims 1, 8, 25 and 28. Because the combination of Emens and Ramanathan fails to teach or suggest each and every claim element, the combination does not render claims 1, 8, 25 and 28 obvious. Applicant respectfully requests reconsideration and the withdrawal of the rejection of claims 1, 8, 25 and 28.

Claims 21-24 and 30 were rejected under 35 USC § 103(a) as being unpatentable over Emens et al. (U.S. 6,606,643) and Ramanathan et al. (U.S. 5,913,041) in view of Andrews et al. (US 2002/0038360). Independent claim 21, similarly to claims 1, 8, 25 and 28 recites "selecting an empirical measurement of performance of each of the plurality of sources, the empirical measurement selected according to a predetermined file size." As discussed above, neither Emens nor Ramanathan teach or suggest the recited language. Further, Applicant has reviewed Andrews and can find no teaching or suggestion of the recited language. As a result, the combination of Emens, Ramanathan and Andrews fails to teach or suggest each and every element of Applicant's claim 21. Thus claim 21 is not obvious in view of the combination of Emens, Ramanathan and Andrews. Applicant respectfully requests reconsideration and the withdrawal of the rejection.

With respect to dependent claims 3-7, 9-11, 19-20, 22-24, 26-27, and 29-30, in addition to the patentable elements provided by the dependent claims, the dependent claims are believed allowable by virtue of their dependency on an allowable base claim. Accordingly, the rejections of the dependent claims based on the combination of Emens and Ramanathan and the combination of Emens, Ramanathan and Andrews is believed overcome. Applicant respectfully requests reconsideration and the withdrawal of the rejections of claims 3-7, 9-11, 19-20, 22-24, 26-27, and 29-30.

Conclusion

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney ((612) 373-6954) to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.


Reservation of Rights

In the interest of clarity and brevity, Applicant may not have addressed every assertion made in the Office Action. Applicant's silence regarding any such assertion does not constitute any admission or acquiescence. Applicant reserves all rights not exercised in connection with this response, such as the right to challenge or rebut any tacit or explicit characterization of any reference or of any of the present claims, the right to challenge or rebut any asserted factual or legal basis of any of the rejections, the right to swear behind any cited reference such as provided under 37 C.F.R. § 1.131 or otherwise, or the right to assert co-ownership of any cited reference. Applicant does not admit that any of the cited references or any other references of record are relevant to the present claims, or that they constitute prior art. Applicant reserves all rights to pursue any cancelled claims in a subsequent patent application claiming the benefit of priority of the present patent application, and to request rejoinder of any withdrawn claim, as required by MPEP § 821.04.

Respectfully submitted,
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By /  /
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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 28th day of June 2007.

Rodney L. Lacy

Name


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